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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/615,967	07/14/2000	Michael P. Lyle	RECOP001	6546

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EXAMINER

HENEGHAN, MATTHEW E

ART UNIT PAPER NUMBER

2134

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/615,967

Applicant(s)

LYLE ET AL.

Examiner

Matthew Heneghan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 18-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 30-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17 and 30-32, drawn to the creation of computer content for a user, based upon the user's characteristics, classified in class 709, subclass 217.
 - II. Claims 18-22, drawn to the creation of redundant computer directories in response to intrusions, classified in class 713, subclass 200.
 - III. Claims 23-29, drawn to the creation and modification of redundant file systems computer directories, classified in class 707, subclass 100.

Invention I is related to inventions II and III as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as the implementation of parental controls on a networked computer. See MPEP § 806.05(d).

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility

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such as testing a new computer configuration in a recoverable manner. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

2. During a telephone conversation with Attorney William James on 5 March 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-17 and 30-32. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. Claims 1-17 and 30-32 have been examined. Claims 18-29 are withdrawn as having been non-elected.

Priority

5. The instant application claims priority to U.S. Provisional Patent Application 60/143,821, filed 14 July 1999 and U.S. Provisional Patent Application 60/151,531, filed 30 August 1999.

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-17 and 30-32 of this application. The contents of the provisional applications teach to the functionality and utility of the instant invention, but do not describe it in a manner that would be enabling. Several of the necessary algorithms are not disclosed, and drawings that would be necessary for the understanding of the invention are not included in the applications.

Information Disclosure Statement

6. The following Information Disclosure Statement(s) in the instant application has been fully considered:

Paper No. 4, filed 15 November 2000.

Drawings

7. The drawings are objected to as failing to comply with 37 CFR 1.84(g) because figures 3, 12, and 13 have margins that are outside specification. A proposed drawing

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correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

8. The drawings are objected to as failing to comply with 37 CFR 1.84(l) because figures 2, 3, 5, 6, 9, 10, and 12 have lines that are not uniformly dense and well-defined. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: item "100." A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

10. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(3) because in figure 7, item 704, the text is not completely within the box. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

11. The use of the trademark Solaris[®] has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-17 and 30-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 17-30, and 35-37 of copending Application No. 09/841,700. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim

1 of 09/841,700 fully anticipates claim 1 of the instant application, as they only differ in the fact that 09/841,700 claims one or more sets of generated content, whereas the instant application only claims one set of generated content; similarly claims 30-32 of the instant application are fully anticipated by claims 35-37 of 09/841,700; and dependent claims 2-17 of the instant application are duplicates of dependent claims 2, 3, and 17-30 of 09/841,700.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "files associated with" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "files associated with"), thereby rendering the scope of the claim unascertainable. For purposes of the prior art search, it is being presumed that this refers to any file on the target system.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-3, 5-11, 14-17, and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Cheswick, "An Evening with Berferd," 1995.

As per claims 1 and 32, the countermeasures taken against a hacker at Stanford University in 1991 included the routing of an intruder to a computer having generated content (see entire document).

As per claim 2, the user's activities were monitored.

As per claim 3, the user was denied access to some of the files, such as the real password file.

As per claim 5, the "Jail" kept input and output logs.

As per claim 6, the user was diverted to the "Jail," away from real content.

As per claims 7-9, the hacker's file requests were routinely screened.

As per claims 10 and 11, additional content was sometimes added to the utmp file in the Jail, for example.

As per claim 14, an indication of the end of the user's session was given (see the trace in "Unfriendly Acts").

As per claims 15-17, decisions were made as to keeping the user's changes (see "The Day After"), and content was added that related to the user's previous session.

As per claims 30 and 31, the "Jail," which was a function of the firewall, generated content.

15. Claims 1, 4, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,913,024 to Green et al.

As per claim 1, Green discloses the routing of users to "burbs," having generated content (see abstract and claims 6 and 7).

As per claim 4, incoming packets are stored on queues (see column 10, lines 32-35).

As per claims 12 and 13, a proxy can be used to route the telnet service to a particular burb.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 4,719,566 to Kelley discloses a method for binding an unauthorized user to a false system.

U.S. Patent No. 5,842,002 to Schnurer et al. discloses a honey pot for catching computer viruses.

U.S. Patent No. 5,870,550 to Wesinger, Jr. et al. discloses a web server creating individual environments on a per-customer basis.

U.S. Patent No. 6,389,458 to Shuster discloses a system for directing users to predetermined information.

U.S. Patent No. 6,408,391 to Huff et al. discloses a system for detecting intrusions, including the use of dummy content.

U.S. Patent No. 6,567,808 to Eschelback et al. discloses a system for segregating security modules.

U.S. Patent No. 6,687,833 to Osbourne et al. disclose a network host decoy with false data for an attacker.

Cohen, "Operating System Protection Through Program Evolution," 1998, discloses methods for modifying files in reaction to intrusions.

"Deception Toolkit" by Fred Cohen, publicly released in the United States no later than January, 1999, includes many of the claimed functionalities.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (703) 305-7727. The examiner can normally be reached on Monday-Thursday from 8:00 AM - 4:00 PM Eastern Time. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached on (703) 308-4789.

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

(703) 872-9306

Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

MEH



March 12, 2004



GREGORY MORSE
SUPERVISORY PATENT EXAMINER
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